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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,524	07/30/2002	Martin Peter	112740-385	8682

29177 7590 07/12/2004

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
PEREZ, JULIO R	
ART UNIT	**PAPER NUMBER**
2681	8

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/019,524	PETER ET AL.	
	Examiner	Art Unit	
	Julio R Perez	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-26 and 28-33* is/are rejected.

7)☒ Claim(s) *27* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 18-26, 28-30, 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Bach et al. (6757534).

Regarding claim 18, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, the method comprising the steps of: defining at least one non-use range in which use of the mobile terminal is not desired, the non-use range being a chronological period (col. 4, lines 4-8, the user may specify a period of one hour to reject unwanted phone calls); monitoring within the mobile radio system whether the non-use range is reached (col. 4, lines 11-17, the clock verifies the designation of the time exhausting); and initiating an action with the mobile radio system if the non-use range has been reached, the action being initiated independently of a current location of

the mobile terminal (col. 4, lines 8-17, the phone would turn off by itself when the period starts and would turn on when the period expires).

Regarding claim 19, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, the method further comprising the steps of: defining the non-use range by a subscriber to the mobile radio system who is assigned to the mobile terminal (col. 4, lines 4-8, the user may specify a period of one hour to reject unwanted phone calls); and signaling, via the subscriber, the non-use range to one of the mobile radio system and a corresponding mobile radio service provider (It is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that in a conventional cellular system the mobile stations and the base stations are in constant communication, where in fact signaling is fact being sent from the time the mobile is turned on).

Regarding claim 20, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, the method further comprising the step of: transmitting a message, to the mobile terminal which requests a subscriber assigned to the mobile terminal to switch off the mobile terminal, automatically as an action for the non-use of the mobile terminal in the mobile radio system (col.4, lines 4-17, the phone internally transmits a signal to turn off itself off automatically via its internal controller command and starting the clock thereafter).

Regarding claim 22, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, wherein the message is transmitted in the form of a call to the

mobile terminal (col. 3, lines 48-55, a call signal is sent to alert about the do-not receive calls mode).

Regarding claim 23, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, the method further comprising the step of actuating a call forwarding facility, which automatically forwards calls for the mobile terminal to a receiver assigned to the mobile terminal, in the mobile radio system at an action for the non-use of the mobile terminal (col. 2, lines 27-30, the system is capable of sending on to a subsequent voice mail system assigned to the user).

Regarding claim 24, Bach et al. teach a method for operating a mobile terminal in a mobile radio system as claimed in claim, the method further comprising the step of using signaling of a call to the mobile terminal as an action for the non-use of the mobile terminal (col. 3, lines 48-63, the mobile terminal is signaled with a signal to advise of the special mode of the mobile phone of no-calls received).

Regarding claim 25, Bach et al. teach a method for operating a mobile terminal in a mobile radio system, the method further comprising the step of transmitting an appropriate optical signal from the mobile radio system to a subscriber to the mobile radio system, who is assigned to the mobile terminal, as an action for the non-use of the mobile terminal (col. 3, lines 63-67, the user is alerted via visual means of the non-receive call status).

Regarding claim 26, Bach et al. teach a method for operating a mobile terminal in a mobile radio system as claimed in claim, the method further comprising the step of: deactivating, automatically, the mobile terminal within the mobile radio system as an

action for the non-use of the mobile terminal (col. 4, lines 6-14, the mobile phone will be rendered inactive at the start of the specified period).

Regarding claim 28, Bach et al. teach a method for operating a mobile terminal in a mobile radio system as claimed in claim 18, the method further comprising the step of: displaying, automatically, on a display of the mobile terminal a corresponding message which provides information on the instantaneous operating state of the mobile terminal after the initiation of an action for the non-use of the mobile terminal (col. 3, lines 48-67, a subscriber is alerted of the special mode, in which the mode is, that is, non-receive calls).

Regarding claim 29, Bach et al. teach a method for operating a mobile terminal in a mobile radio systems, the method further comprising the step of: reversing the initiated action for the non-use of the mobile terminal if the mobile terminal leaves the non-use range again (col. 4, lines 4-17, the mobile phone turns back on automatically after the preset period for receiving unwanted calls have been exhausted).

Regarding claim 30, Bach et al. teach a mobile radio system, comprising: at least one base station (col. 1, lines 15-29, per the background, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that a cellular system is composed of base stations as well as mobile phones in order to establish communication within a mobile system); at least one mobile terminal (col. 1, lines 15-29, per the background, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that a cellular system is composed of base stations as well as mobile phones in order to establish communication within a mobile system); a

mobile radio channel via which communication between the at least one base station and the at least one mobile terminal is transmitted (col. 1, lines 15-29, per the background, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that a cellular system is composed of base stations as well as mobile phones in order to establish communication within a mobile system through a communication link over the air), at least one non-use range being defined in which use of the mobile terminal is not desired (col. 4, lines 4-8, the user may specify a period of one hour to reject unwanted phone calls); and control parts for monitoring whether the non-use range is reached, the control parts configured such that an action for non-use of the mobile terminal is initiated if the non-use range has been reached, a chronological period being defined as the non-use range (col. 4, lines 4-17, the clock verifies the designation of the time period being exhausted; the phone would turn off by itself when the period starts and would turn on when the period expires), and an action for the non-use of the mobile terminal being initiated independently of a current location of the mobile terminal if the non use range has been reached(col. 4, lines 4-17, the clock verifies the designation of the time period being exhausted; the phone would turn off by itself when the period starts and would turn on when the period expires, the process of which is not contingent on the location of the user).

Regarding claim 32, Bach et al. teach a mobile radio system, wherein the control parts are integrated into the mobile terminal (col. 4, lines 8-17, the mobile phone contains a clock within itself, which, indeed, provides controlling tasks.

Regarding claim 33, Bach et al. teach a mobile radio system, wherein the control parts are assigned to a mobile radio service provider (col. 2, lines 27-30 and per the prior art background, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that a mobile radio operator contains means of taking part on the tasks required to act on the system functions).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. (6757534).

Regarding claim 31, Bach et al. teach all the limitations in claim 30.

Bach et al. fail to specifically disclose the control parts are assigned to the base station of the mobile radio system.

However, the preceding limitation is well known in the art of mobile communications.

Bach et al. strongly suggest the use of a cellular system, a system of which conventionally comprises a group of base stations and mobile stations; the base stations conventionally contain the controlling means to provide communications and commands to control the mobile stations (col. 1, lines 25-40; col. 2, lines 21-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system as taught by Bach et al. to attribute the controlling means to the base station because it would provide a user with extra clear features of the system commands.

Allowable Subject Matter

5. Claim 27 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach selecting and initiating, automatically, a specific action as a function of an instantaneous distance from the non-use range, a severity of the selected action increasing as a distance from the non-use range decreases.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the art with respect to mobile communication devices with respect to call restriction in function of mobile location or period of time.

US Pat. No. 6091949 to Sanchez	Barring call forwarding.
US Pat. No. US006463289B1 to Havinis et al.	Restricting positioning of mobile station.
US Pat. No. US006175743B1 to Alperovich et al.	Short messages to restricted subscribers.
US Pat. No. US006233447B1 to Tomoike	Incoming call rstriction.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R Perez whose telephone number is (703) 305-8637. The examiner can normally be reached on Monday - Friday, 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP
7/6/04

ERIKA GARY
PATENT EXAMINER